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10/671,162	09/25/2003	Barry J. Gilhuly	1400-1072C4	7030
47243 7590 04/24/2009 THE DANAMRAJ LAW GROUP, P.C. PREMIER PLACE, SUITE 1450 5910 NORTH CENTRAL EXPRESSWAY DALLAS, TX 75206				
EXAMINER				
STRANGE, AARON N				
ART UNIT		PAPER NUMBER		
2448				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/671,162

**Applicant(s)**

GILHULY ET AL.

**Examiner**

AARON STRANGE

**Art Unit**

2448

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 71-81 and 84-95 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 71-81 and 84-95 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

#### **DETAILED ACTION**

1. In the interest of expedited prosecution, the Examiner would like to recommend conducting an interview prior to filing a response to the present Office action. The Examiner feels that an interview would help foster a mutual understanding of the respective positions of Applicant and the Examiner, and assist in the identification of allowable subject matter and/or issues for appeal. If Applicant agrees that an interview would be beneficial, he/she is encouraged to contact the Examiner to schedule one.

#### ***Response to Arguments***

2. With regard to claim 71, and Applicant's assertion that Tello "does not teach or suggest a first email address associated with the user's computer for the data items" (Remarks 14-16), the Examiner respectfully disagrees. As an initial matter, it is noted that the language "associated with" is very broad and requires a minimal relationship between the user's computer and the first address to be anticipated. The well-known name address taught by Tello is associated with the ISP's mail server, which is analogous to the server 115 in Eggleston, which also processes electronic messages for the user. When considered in combination, Eggleston and Tello teach a first and second address associated with the user, wherein the first address is associated with a host device such as an email server and the second address is associated with a mobile device.

3. Applicant's remaining arguments with respect to claims 71-81 and 84-95 have been considered but are moot in view of the new ground(s) of rejection.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 71, 84 and 95 (as currently amended) are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 65, 97 and 108 of copending Application No. 09/782,412 and claims 90, 99 and 105 of copending Application No. 09/782,107. This is a provisional obviousness-type double patenting rejection. Although the conflicting claims are not identical, they are not patentably distinct from each other. Claims 65, 97 and 108 of copending Application No. 09/782,412 and claims 90, 99 and 105 of copending Application No. 09/782,107 contain

all of the limitations of claims 71, 84 and 95, and all three applications claim the principal feature of common addressing using an outer envelope.

Since all of the claim sets claim substantially the same invention, and the differences between them are old and well known, the claims are not patentably distinct and are provisionally rejected on the ground of nonstatutory obviousness-type double patenting.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 84-94 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

8. Claim 84 is directed to a plurality of "means for" performing various functions. The specification of the present application discloses that the redirector program performs these functions. Since the redirector program is a software program, the disclosure would have suggested to one of ordinary skill in the art that the claimed means are intended to include software-only embodiments. Since the claim is not limited to statutory subject matter, it is non-statutory.

9. All claims not individually rejected are rejected by virtue of their dependency from the above claims, and their failure to remedy the above noted deficiencies.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 71, 72, 74, 77, 79, 84, 85, 87, 90, 92 and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (US 5,958,006) in view of Carthy et al. (MAPI Developers Forum post "MAPI Notification", April 12, 1996) further in view of Tello et al. (US 6,381,634) further in view of Hall et al. (US 5,826,023).

12. With regard to claim 71, Eggleston discloses a wireless system coupled to a messaging host (post office host server) and to a wireless data network (network accessible via BS1)(col. 4, ll. 52-55) that provides an interface for one or more data items (email messages) associated with a user's computer between the messaging host and the wireless data network, the wireless system comprising:

redirector means (communication server) for detecting the one or more data items (VSM in communication server checks for unread mails in the users post office box)(col. 6, ll. 56-61), the redirector means interfacing with the messaging host via a

wide-area packet network (post office may be coupled to VSM by a WAN)(col. 4, ll. 57-61), wherein the one or more data items are received at the messaging host (emails are received by and stored at the post office)(col. 6, ll. 61-63) and have a first address associated with the user's computer (email messages are inherently associated with the user's computer since they are received by and stored in the user's post office box)(col. 4, ll. 56-63); and

wireless gateway means for interfacing the data items to the wireless data network (VSM forwards the emails to the mobile device via the wireless network)(col. 6, l. 66 to col. 7, l. 6).

However, Eggleston fails to specifically disclose that the redirector detects the data items using an automatically generated notification, that the data items are packaged in an envelope having a second address to provide one or more packaged data items, or that the redirector includes logic for removing an outer envelope of a data item repackaged at and received from the mobile data communication device.

Carthy discloses a similar system where the notification of new messages in a user's mailbox is sent automatically, as opposed to polling, using an extended MAPI IMAPAdviseSink notification (See the Carthy post describing "full asynchronous" notification in extended MAPI). Carthy further discloses that in order to receive these automatic notifications the system must register with a software interface associated with the messaging server (i.e. registering with the ImsgStore to receive adviseSinks). Cathy also disclosed that automatic notification is preferable to polling (see the Cohen post below: "Today I do a polling on each mailbox : I open a connection through MAPI

functions, I consult, I notify if new mail, and I close the connection. Then I go to the next mailbox and do the same actions. It's not great @. So I'd like to know whether -there-exists another way to notify with MAPI, especially a "fully asynchronous" notification"). This would have been an advantageous addition to the system disclosed by Eggleston since the detection process alerts the system immediately upon arrival of new messages, eliminating the delay associated with polling each user's mailbox.

Tello also discloses a similar system for forwarding e-mail messages from a host system associated with a first e-mail address to a second system associated with a second e-mail address. Tello teaches receiving an e-mail message at a host machine (ISP mail server) associated with a first e-mail address (well-known-name value 505)(col. 4, II. 43-48; col. 5, II. 29-33), and redirecting the message to a second address associated with the recipient (well-known-name-value is converted into literal address for redirection)(col. 5, II. 33-39). Tello further discloses that the user's well-known name address remains unchanged, even if the literal address associated with it changes (col. 5, II. 56-67), permitting e-mail address portability (col. 5, II. 58-60). This would have been an advantageous addition to the system disclosed by Eggleston since it would have allowed users to maintain a single email address that repackaged received messages for delivery to a second address associated with the user's current location.

Hall discloses a similar system for transporting an electronic mail message across different network types (Abstract). Hall teaches encapsulating an electronic mail created for transmission via a first network in outer envelopes for transmission over a second type of network (col. 2, I. 45 to col. 3, I. 8). Hall further discloses that the outer



envelope is removed at either end of the tunnel and the message is processed as usual (col. 3, ll. 3-8). This would have been an advantageous addition to the system disclosed by Eggleston and Tello since it would have allowed the e-mail and reply messages to be created in the same format and simply tunneled over the wireless network using an outer envelope. This would have advantageously eliminating the need to convert messages between formats used by different networks.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to automatically notify the redirection device of newly received messages and permit forwarding of messages to a second address associated with the user to ensure that received messages were immediately sent to the user's current location, as well as to transmit the messages over the wireless network using an outer envelope to eliminate the need to convert message formats for communication over different network types.

13. With regard to claim 72, Tello further discloses that the one or more data items interfaced to the wireless data network are original data items (email message is forwarded to the appropriate address without modification)(col. 5, ll. 36-39).

14. With regard to claim 72, Eggleston further discloses a mobile device adapted to receive the data items packaged with the second address and interfaced through the wireless data network (col. 4, ll. 51-55).

15. With regard to claim 74, Eggleston further discloses that the one or more data items are compressed data items (messages may be compressed)(col. 11, ll. 63-67).

16. With regard to claim 77, Eggleston further discloses that the one or more data items interfaces to the wireless data network are copies of the data items (a copy of the message is retained at the server and sent to the wireless network)(col. 12, ll. 32-39 and 59-62).

17. With regard to claim 79, Eggleston further discloses that the one or more data items are compressed data items (messages may be compressed)(col. 11, ll. 63-67).

18. Claims 84, 85, 87, 90, 92 and 95 are rejected under the same rationale as claims 71, 72, 74, 77 and 79, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

19. Claims 73, 78, 86 and 91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (US 5,958,006) in view of Carthy et al. (MAPI Developers Forum post "MAPI Notification", April 12, 1996) further in view of Tello et al. (US 6,381,634) further in view of Hall et al. (US 5,826,023) further in view of Murota (US 6,289,105).

20. With regard to claim 73 and 78, while the system disclosed by Eggleston, Carthy and Tello shows substantial features of the claimed invention (discussed above), it fails to disclose that the one or more data items are encrypted data items.

Murota discloses a similar system for sending e-mail messages between a sender and a receiver, wherein a message is encrypted at the sending end, is then transmitted over the network to the receiving end, and is finally decrypted at the receiving computer (col. 1, ll. 23-48). Murota further discloses that such an encryption scheme is advantageous because it prevents leaks of secret information to outside, non-intended parties (Murota, col. 1, ll. 49-53).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to encrypt the data items to prevent unauthorized parties from accessing the contents of the data items.

21. Claims 86 and 91 are rejected under the same rationale as claims 73 and 78, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

22. Claims 75, 80, 88 and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (US 5,958,006) in view of Carthy et al. (MAPI Developers Forum post "MAPI Notification", April 12, 1996) further in view of Tello et al.

(US 6,381,634) further in view of Hall et al. (US 5,826,023) further in view of Official Notice.

23. With regard to claims 75 and 80, while the system disclosed by Eggleston, Carthy and Tello shows substantial features of the claimed invention (discussed above), it fails to disclose that the data items are repackaged using MIME.

The Examiner takes Official Notice that MIME was an old and well known standard for formatting email messages at the time the invention was made. Formatting messages using MIME would have merely been a predictable variation of the formatting used by Eggleston, Carthy and Tello, since it was a widely used formatting standard for email messages.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use MIME to repackage the data items.

24. Claims 88 and 93 are rejected under the same rationale as claims 75 and 80, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

25. Claims 76, 81, 89 and 94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (US 5,958,006) in view of Carthy et al. (MAPI Developers Forum post "MAPI Notification", April 12, 1996) further in view of Tello et al.

(US 6,381,634) further in view of Hall et al. (US 5,826,023) further in view of Halim et al. (US 6,304,881).

26. With regard to claim 76 and 81, while the system disclosed by Eggleston, Carthy and Tello shows substantial features of the claimed invention (discussed above), it fails to disclose that the data items are repackaged using IMAP.

Halim discloses a similar system for forwarding email messages to a remote device. Halim teaches the user of IMAP for retrieving email messages from an email server (col. 1, ll. 59-63). This would have been an advantageous addition to the system disclosed by Eggleston, Carthy and Tello since it would have allowed IMAP users to have their email redirected to a wireless device.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use permit IMAP users to redirect email messages to a wireless device.

27. Claims 89 and 94 are rejected under the same rationale as claims 76 and 81, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

***Conclusion***

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON STRANGE whose telephone number is (571)272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Firmin Backer can be reached on 571-272-6703. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron Strange/  
Examiner, Art Unit 2448